

REMARKS

R consideration of the application is requested in view of the modifications above and the remarks below. Applicants acknowledge indication of allowable subject matter in Claims 61-64. Applicants have made the modifications to place the application in condition for allowance or in better form for appeal.

Rejections Under 35 USC 112

1. The Office Action rejected Claims 56-60, 66 and 67 under 35 USC 112, second paragraph as indefinite.

Claim 56 is directed to a process for preparing a cyclic compound including subjecting a starting material in the presence of a catalyst component to metathesis reaction in the presence of an ionic liquid, and thereby forming the cyclic compound. Claim 56 has been amended to include that "the catalyst component is a ruthenium, an osmium, or a molybdenum homogenous catalyst or a heterogeneous catalyst selected from the group consisting of (i) ruthenium, an osmium, or a molybdenum metal carbenes, (ii) transition metal compounds that form transition metal carbenes under the reaction conditions, and (iii) transition metal salts in combination with an alkylating agent."

The Office Action indicates that "compounds that form transition metal carbenes under the reaction conditions and alkylating agent remain unduly functional. Applicants are attempting to define structure of specific chemical compounds used in Applicants' claimed process. Names, structure, and chemical formulas precisely define organic molecules... The skilled process chemist, who would use Applicants' invention, would not recognize what compounds were intended using this language". (Office Action, page 3, ll. 1-8).

A functional limitation is an attempt to define something by what it does rather than what it is, and there is nothing inherently wrong with defining some part of an invention in functional terms (MPEP 2173.05(g)). Functional language does not, in and of itself, render a claim improper. In *re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the art.

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pertinent art in the context in which it is used (MPEP 2173.05(g)). A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step (MPEP 2173.05(g)).

Amended Claim 56 includes the catalyst component is a ruthenium, an osmium, or a molybdenum homogenous catalyst or a ruthenium, an osmium, or a molybdenum heterogeneous catalyst selected from the group consisting of (i) transition metal carbenes, (ii) transition metal compounds that form transition metal carbenes under the reaction conditions, and (iii) transition metal salts in combination with an alkylating agent. The "transition metal compounds that form transition metal carbenes under the reaction conditions," and "transition metal salts in combination with an alkylating agent" are used in association with an element, either the homogeneous catalyst or heterogeneous catalyst, to define a particular capability or purpose that is served by the element. Thus, one of ordinary skill in the art would recognize what compounds were intended in Applicants' Claim 56.

Claims 57-60, 66 and 67 depend from independent Claim 56 which as discussed above is believed to be allowable. Accordingly Claim 57-60, 66 and 67 are also believed to be allowable. Reconsideration is requested.

2. The Office Action rejected claim 65 under 35 USC 112, second paragraph as indefinite.

In light of the comments in the outstanding Office Action, Claim 65 has been amended to include "TfO" Support for this amendment is found at page 16, line 21. Reconsideration is requested.

3. The Office Action rejected Claim 56-60, 66 and 67 under 35 USC 112, second paragraph.

In light of the comments in the outstanding Office Action, Claim 56 has been amended to include a ruthenium, an osmium, or a molybdenum

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homogenous catalyst or a heterogeneous catalyst selected from the group consisting of (i) ruthenium, osmium, or molybdenum metal carbenes...

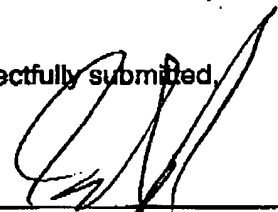
Thus, indicating the transition metals, and therefore one skilled in the art would know how to practice the invention without undue experimentation.

Claims 57-60, 66 and 67 depend from independent Claim 56 which as discussed above is believed to be allowable. Accordingly Claim 57-60, 66 and 67 are also believed to be allowable. Reconsideration is requested.

In view of the remarks above, a Notice of Allowance is earnestly requested.

Respectfully submitted,

By


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